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| EXAMINER |
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DIXON, THOMAS A

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| ART UNIT | PAPER NUMBER |
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3629

DATE MAILED: 02/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/756,366

Applicant(s)

FIALA ET AL.

Examiner

Thomas A. Dixon

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 11, 28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The identification of the member's sexual preference is not supported by the specification.

### ***Claim Rejections - 35 USC § 112 2<sup>nd</sup> Paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the first and second destinations" in line 12. There is insufficient antecedent basis for this limitation in the claim. Further, it is unclear who or how the identifying of a travel destination of interest is identified, it appears that it is the first party, mentally deciding, "it might be fun to go to ...," rather than any technology.

### ***Claim Interpretation***

3. Claims directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claims 12-16, including a member database, a search engine an interface and a message server are disclosed in Robertson (6,269,369) as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-11, 17-35 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention is not within the technological arts.

As per Claims 1, 17, 29, 33

The claim contains a "member database," but this could merely be a card file and the identifying and submitting step are merely passing a hand-written note to a person who thumbs through the card file and compiles a list with paper and pencil and passes a hand-written note to the second member, and therefore, is not seen to be in the technological arts. The dependent claims do not add any technology.

5. As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

6. Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450 U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

7. This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject

matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

8. The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-30 are rejected under 35 U.S.C. 102(e) as being anticipated by

Robertson (6,269,369).

As per Claim 1.

Robertson ('369) discloses:

identifying a travel destination of interest to the first member, the identified travel destination, see figure 12 (660-2, 660-4, 660-6);

submitting a search request to the member database for members having an association with the identified travel destination, see column 14, lines 1-20;

receiving a list comprising a group of members having an association with the identified travel destination, see figure 12 (670);

sending a message to the second member, the message comprising information related to the identified travel destination, see (670-4, 670-6, 670-8, and 670-10).

As per Claim 2, 19.

Robertson ('369) further discloses a date restriction and members will be present at the identified travel destination at a time included within the date restriction, see figure 12 (660-10, 660-20, and 670-2).

As per Claim 3, 20.

Robertson ('369) further discloses a notice that the first member will be at the identified travel destination during a time within the date restriction, see column 14, lines 57-61.

As per Claim 4, 21.

Robertson ('369) further discloses the identified travel destination comprises a geographic location to which the first member plans to travel, see column 13, line 66 – column 14, line 1.

As per Claim 5, 22.

Robertson ('369) further discloses the search request further comprises a request for members who also plan to travel to the identified travel destination, see column 14, lines 44-49.

As per Claim 6, 23.

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Robertson ('369) further discloses the search request further comprises a request for members who also plan to travel to the identified travel destination at a time within a predetermined date restriction, see column 14, lines 44-49.

As per Claim 7, 24.

Robertson ('369) further discloses the identified travel destination comprises the second geographic location, see column 14, lines 33-36.

As per Claim 8.

Robertson ('369) further discloses submitting a geographic location to which the first member plans to travel, see column 13, line 66 – column 67, line 1.

As per Claim 9.

Robertson ('369) further discloses submitting a geographic location to which the first member plans to travel, see column 13, line 66 – column 67, line 1.

As per Claim 10, 27.

Robertson ('369) further discloses one or more personal parameters to further limit members included in the list, see column 13, line 66 – column 14, line 1.

As per Claim 11, 28.

Robertson ('369) further discloses the personal parameters comprise at least one of: age, appearance, marital status, interests, hobbies of members that may be included in the list, figure 6 (440-16).

As per Claim 12.

Robertson ('369) discloses:

a member database, see figure 5 (340);

a search engine, see figure 5 (334), and column 14, lines 1-20;

an interface, see figure 12;

a message server, see figures 5 (330) and 12 (670-4, 670-6, 670-8, and 670-10).

As per Claims 13-16.

The limitations of the claims do not distinguish the claimed apparatus from the prior art.

As per Claim 17.

Robertson ('369) discloses:

providing access to a member database comprising identities of members and geographic data related to respective members, the geographic data comprising residence location of the respective members and travel destinations of interest to the respective members, see figure 12 (660, 670);

receiving a search request from a first member searching for other members having an association with a travel destination, see column 14, lines 1-20;



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searching the member database for members satisfying the search request, see column 14, lines 25-61;

sending a list to the first member, the list comprising a group of identities of members having an association with the travel destination, the group including a second member, see figure 12 (670);

receiving a message from the first member intended for the second member, see (670-4, 670-6, 670-8, and 670-10);

sending the message to the second member, see column 14, lines 57-61.

As per Claim 18.

Robertson ('369) further discloses a data comprising times when members will be at respective travel destinations, see figure 12 (660-10, 660-20, and 670-2).

As per Claim 25.

Robertson ('369) discloses a lookup of the first member's residence, see column 14, lines 62-67.

As per Claim 26.

Robertson ('369) further discloses the list comprises a group of surrogate identities of members having an association with the travel destination and wherein the sending step comprises determining an address for the second member based upon a surrogate identity included in the message, see figures 10 (634-2) and 12 (Betsy is seen to be a surrogate name, as it is a known nickname for Elizabeth).

As per Claim 29.

Robertson ('369) discloses:

providing access to a member database comprising surrogate identities of members and geographic data related to respective members, the geographic data comprising residence location of the respective members and travel destinations of interest to the respective members, see figures 10 (634-2) and 12 (660, 670);

receiving a search request from a first member searching for other members having an association with a travel destination, see column 14, lines 1-20;

searching the member database for members satisfying the search request, see column 14, lines 25-61;

sending a list to the first member, the list comprising a group of surrogate identities of members having an association with the travel destination, the group including a second member, see figure 12 (670) (Betsy is seen to be a surrogate name, as it is a known nickname for Elizabeth);

receiving a message from the first member intended for the second member, see (670-4, 670-6, 670-8, and 670-10);

sending the message to the second member, see column 14, lines 57-61.

As per Claim 30.

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Robertson ('369) further discloses a data comprising the real identities of members, see figure 10 (634).

As per Claim 33.

Robertson ('369) discloses:

providing access to a member database comprising surrogate identities of members and geographic data related to respective members, the geographic data comprising intended travel destinations of the respective members and dates of intended travel to respective travel destinations, see figure 12 (660, 670);

receiving a search request from a first member comprising an identified travel destination and a date restriction, see (660-2, 660-4, 660-6, 660-10 and 660-20);

searching the member database for members satisfying the search request, see column 14, lines 25-61;

sending a list to the first member, the list comprising a group of identities of members having an association with the travel destination, the group including a second member, see figure 12 (670).

As per Claim 34.

Robertson ('369) further discloses

receiving a message from the first member intended for the second member, see (670-4, 670-6, 670-8, and 670-10);

sending the message to the second member, see column 14, lines 57-61.

As per Claim 36.

Robertson ('369) further discloses one or more personal parameters to further limit members included in the list, see column 13, line 66 – column 14, line 1.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robertson (6,269,369).

As per Claim 31.

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Robertson ('369) further discloses storage of customerid, userid and email and further an area for a contact method in the message, but does disclose that the message contains the surrogate identity of the first member.

Official Notice is taken that email addresses are well known in the computer arts as a method of contact.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made that it would be obvious that any text could be in the "how to contact" portion of the message of Robertson, including a surrogate identity such as an email address for the benefit of using a well known method of contact.

As per Claim 32.

Robertson ('369) discloses informing the second member how to contact the first member, which could include a surrogate identity, the second member can determine the identity of the first member from the first member's contact, but does not disclose sending a response.

Official notice is taken that email is an old and well known in the computer arts and further it is old and well known to respond to email.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to respond to the email send from a person who contacts you.

#### ***Prior Art Made of Record***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

6,20,204 to Desai et al discloses differing access permissions based on the userid or surrogate identity of the person requesting access.

6,785,686 to Boreham et al discloses a high level view of a system for searching for members of a group and further allows the members to choose their Preferred Delivery Method for communications within the system.

6,742,032 to Castellani et al discloses a system to monitor community activity and generate activity when communities are sleeping.

20020095298 to Ewing discloses a system that allows gifts to be given when only a pseudonym or surrogate identity is known, and further allowing the gift giver to use only a pseudonym or surrogate identity.

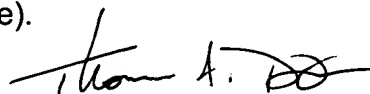
JP 2002157190 to Maehiro is the closest foreign art, but is not applicable datewise.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (571) 272-6803. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas A. Dixon  
Primary Examiner  
Art Unit 3629

February 05